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SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

EXAMINER

FRONDA, CHRISTIAN L

ART UNIT PAPER NUMBER

1652

DATE MAILED: 06/30/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/341,600

Applicant(s)

BERRY ET AL.

Examiner

Christian L Fronda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 40-70 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

1. Claims 40-70 are under consideration in this Office Action. The rejection under 35 U.S.C. 112, first paragraph, has been corrected and the other rejections stated in the previous Office Action are reiterated in the instant Office Action.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 40-47, 51, 53-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 9, 13-15, 26-33, 37-39, and 50 of U.S. Patent No.6,372,457. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

The method of the instant application uses any nucleic acid encoding any glucosamine-6-phosphate synthase from any biological source while the method of in U.S. Patent No.6,372,457 is identical to the method of the instant application except that the method in U.S. Patent No.6,372,457 uses a nucleic acid encoding glucosamine-6-phosphate synthase from *E.coli*. The scope of the method of the instant application encompasses a genus of nucleic acids encoding glucosamine-6-phosphate synthases from many biological sources and the said genus includes a nucleic acid encoding glucosamine-6-phosphate synthase from *E.coli* which is recited in the method claims of U.S. Patent No.6,372,457. Thus, allowance of the method claims of the instant application would improperly extend the "right to exclude" already granted in U.S. Patent

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No.6,372,457.

Claim Rejections - 35 U.S.C. § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 40-70 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

Claims 40-70, as written, do not sufficiently distinguish over nucleic acids, proteins, cells, or antibodies as they exist naturally because the claims do not particularly point out any non-naturally occurring differences between the claimed products and the naturally occurring products. In the absence of the hand of man, the naturally occurring products are considered non-statutory subject matter. *See Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980). The claims should be amended to indicate the hand of the inventor, e.g., by insertion of "transformed microorganism" or "recombinant microorganism". See MPEP 2105.

Claim Rejections - 35 U.S.C. § 112, 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 40-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants' arguments filed January 19, 2001 (paper no. 14), have been fully considered but they are not persuasive. Applicants argue that the specification is enabling and that it is not necessary to have prior knowledge of the amino acid sequence of the claimed glucosamine-6-phosphate synthase in order to obtain mutants with the desired property of increased enzyme activity.

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The nature and breadth of the claims encompass any microorganism comprising any nucleic acid having any genetic modification that increases glucosamine-6-phosphate synthase activity including changing any nucleotide in the nucleic acid encoding said glucosamine-6-phosphate synthase or reduction of product inhibition of glucosamine-6-phosphate synthase activity, and the use of the claimed microorganism for the production of glucosamine. The claimed microorganism further contains any genetic modification of a list of enzymes recited in claim 57-60 and 68 and genetic modifications of a list of genes recited in claim 65.

The specification does not provide guidance in making any microorganism comprising any genetic modification that increases glucosamine-6-phosphate synthase action or any genetic modification in a nucleic acid sequence encoding glucosamine-6-phosphate synthase. Furthermore, the specification does not provide guidance for any genetic modification of the list of enzymes recited in claim 57-60 and 68 and genetic modifications of the list of genes recited in claim 65.

The amount of experimentation to obtain the claimed microorganism for use in the production of glucosamine is undue because one skilled in the art would have to select a type of genetic modification out of a vast number of modifications to perform on the claimed microorganism, such as replacing the wild-type promoter of glucosamine-6-phosphate synthase with a high expression promoter, deleting, inserting, substituting, or combinations thereof to the nucleic acid encoding the amino acid sequence of glucosamine-6-phosphate synthase, or selecting proteins and enzymes other than glucosamine-6-phosphate synthase to genetically modify; expressing the glucosamine-6-phosphate synthase mutant, measuring the activity of said mutant; and determining whether the selected mutation results in an increase in glucosamine-6-phosphate synthase action. .

Since routine experimentation in the art does not include making a vast number of glucosamine-6-phosphate synthase mutants, and screening and selecting said mutants that have an increase in glucosamine-6-phosphate synthase action where the expectation of obtaining the desired mutation which results in an increase in glucosamine-6-phosphate synthase action is unpredictable, the Examiner finds that one skilled in the art would require additional guidance, such as the specific type of genetic modification to perform on the specific proteins or enzymes of claimed microorganism, the amino acid residues which can be modified that lead to the claimed effect, or the gene encoding the said synthase and its biological source. Without such a guidance, the experimentation left to those skilled in the art is undue.

The Declaration of Ming De Deng filed 2/19/02 (Paper No. 20) has been acknowledged but does not provide enablement for the following reasons: The declaration states that the wild-type genes encoding the *B.subtilis* glucosamine-6-phosphate synthase, *C.albicans* glucosamine-6-phosphate synthase, and *S.cerevisiae* glucosamine-6-phosphate synthase were obtained, transformed into host cells, and glucosamine production measured. The declaration states that nucleotide sequences of the said genes has low homology to *E.coli* glucosamine-6-phosphate

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synthase (Table 1).

However, the declaration does not teach how to make any microorganism comprising any genetic modification that increases glucosamine-6-phosphate synthase action or any genetic modification in a nucleic acid sequence encoding glucosamine-6-phosphate synthase including deletion, insertion, substitution, or combinations thereof of specific nucleotide(s). Thus, without further guidance, the experimentation left to those skilled in the art is undue

8. Claims 40-70 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 40-70 are genus claims that are directed toward any microorganism comprising any nucleic acid having any genetic modification that increases glucosamine-6-phosphate synthase activity or reduction of product inhibition of glucosamine-6-phosphate synthase activity, and the use of the claimed microorganism for the production of glucosamine. The scope of the claim includes many microorganisms, many glucosamine-6-phosphate synthases of any structure and amino acid sequence from any biological source, and many genetic modifications to obtain the desired property. Furthermore, the genus is highly variable because a significant number of structural differences between genus members is permitted.

The specification fails to describe additional representative species of the claimed genus other than transforming the gene for E.coli glucosamine-6-phosphate synthases into a host cell for production of glucosamine. Furthermore, since the Declaration of Ming De Deng filed 2/19/02 (Paper No. 20) states that nucleotide sequences of the genes from B.subtilis, C.albicans, and S.cerevisiae encoding glucosamine-6-phosphate synthase has low homology to E.coli glucosamine-6-phosphate synthase (Table 1), then the gene for E.coli glucosamine-6-phosphate synthase is not representative of the claimed genus since there is no common structural features shared between members of the genus.

Given this lack of additional representative species as encompassed by the claims, Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention.

Claim Rejections - 35 U.S.C. § 112, 2nd Paragraph

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 40-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 40 (i), the phrase "encoding glucosamine-6-phosphate synthase which has glucosamine-6-phosphate synthase activity" is confusing since the nucleic acid encodes that enzyme and the nucleic acid itself does not have any enzymatic activity. Claims 41-70 which depend from claim 40 are also rejected because they do not correct the defect of claim 40.

Claim Rejections - 35 U.S.C. § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 67 is rejected under 35 U.S.C. 102(b) as being anticipated by Dutka-Malen et al. Dutka-Malen et al. reference has been attached to the previous Office Action dated [7/20/00 (Paper No. 7)] and is not attached to the instant Office Action.

Dutka-Malen *et al.* make a genetically engineered *E.coli* host cell (see **Fig. 1**, p. 288) which is transformed with a recombinant vector containing the *E.coli* gene encoding glucosamine-6-phosphate synthase suitably linked to a *lac* promoter wherein said host cell overexpresses glucosamine-6-phosphate synthase as evident by an increase in enzyme activity. Glucosamine-6-phosphate synthase catalyzes the formation of glucosamine-6-phosphate. Genetic modifications include transformation of *E.coli* host cells with a recombinant vector containing a nucleic acid sequence which encodes glucosamine-6-phosphate synthase and overexpression of said synthase. Furthermore, linking the nucleic acid sequence encoding glucosamine-6-phosphate synthase to said *lac* promoter in said recombinant vector is a mutation to the glucosamine-6-phosphate synthase gene (*glms*).

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the

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intended use, then it meets the claim. In the instant case the genetically engineered *E.coli* host cell taught by Dutka-Malen et al. meets the limitations of the claim since there is no structural difference between the claimed microorganism and the *E.coli* host cell taught by Dutka-Malen et al. Thus, the reference teachings anticipate the claimed invention.

Conclusion

13. No claim is allowed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L Fronda whose telephone number is (571)272-0929. The examiner can normally be reached Monday-Friday between 9:00AM - 5:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura N Achutamurthy can be reached on (571)272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CLF



PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600